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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,172	03/17/2004	Agnes Jallouli	ESSR:080US/10403554	3841
33425 7590 10/08/2009 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				
EXAMINER				
BURKHART, ELIZABETH A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,172

**Applicant(s)**

JALLOULI ET AL.

**Examiner**

Elizabeth Burkhart

**Art Unit**

1792

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 7-22 and 24-64 is/are pending in the application.
- 4a) Of the above claim(s) 11, 28, 47 and 62-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7-10, 12-22, 24-27, 29-46 and 49-61 is/are rejected.
- 7) ☒ Claim(s) 19 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 7-22, and 24-64 are pending in the application. Amended claims 1, 7, and 22 and cancelled claims 2-6 and 23 have been noted. Claims 11, 28, 47, and 61-64 were withdrawn from consideration as being drawn to a non-elected invention.

#### ***Election/Restrictions***

2. Applicant argues that the Examiner has not addressed the substance of Applicant's argument with respect to rejoinder of Group II, namely that the Examiner failed to prove that the device as claimed could be used in another materially different process. Applicant further argues that the device of claim 62 comprises parts especially dedicated to handling lenses and is completely unable to be used to coat semiconductor wafers because the claimed holder is suitable for lenses (which tend to be millimeter-thick articles) and not a semiconductor wafer (which tend to be micrometer-thick articles). This is not found persuasive because the system as claimed is indeed capable of being used to coat different substrates than just lenses, of which semiconductor wafers are a valid example, since semiconductor wafers may also be millimeter-thick articles as evidenced in [0048] of Hopfner (US 2002/0086532). Also, Bracher et al ('128) provides further evidence that the system as claimed is capable of being used to coat different substrates than just optical lenses, such as spectacle lenses or filter plates (Col. 4, lines 1-8).

The requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election with traverse of Species A in the Species Election Requirement in the reply filed on February 11, 2008 is acknowledged. The traversal is

on the ground(s) that the entire subject matter of Claim 61 is not patentably distinct over claim 57. Due to this admission and the admission filed 2/11/08 that Species A (claim 57) and Species B (claim 61) are obvious variants of one another, the Species Election Requirement of 1/10/08 is withdrawn.

4. This application contains claims 11, 28, 47, and 62-64 drawn to an invention nonelected with traverse in the reply filed on 7/2/08 and 2/11/08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Specification***

5. The abstract of the disclosure is objected to because legal phraseology is used. The abstract filed 6/26/09 still incorporates legal phraseology, such as "said", which should be avoided. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

#### ***Claim Objections***

6. Claims 19 and 39 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. Claims 19 and 39 depend from cancelled claim 5. For purposes of examination, these claims are considered to be dependent from claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 16-20, 39-42, 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al.

Nakazima discloses a process for applying a coating on at least one main face of at least one optical lens. The lens is dipped in a curable coating composition to deposit a layer, the layer maybe cured to obtain the optical lens.

Nakazima et al does not disclose:

subjecting the at least one main face to a corona discharge or atmospheric plasma treatment;

wherein during the whole process the optical lens is carried by the same lens holder so that said at least one main face is freely accessible and without necessitating manual handling of the lens.

The admitted prior art (page 2, lines 15-25) teaches corona discharge or atmospheric plasma treatment as common, such that one with ordinary skill in the art would have utilized such for the purposes as described by the admitted prior art.

Bracher et al discloses a lens holder (figures 1-4) where a lens with both main faces is freely accessible and without necessitating manual handling of the lens. The lens is maintained through its periphery by contact points. There are arms (1a-1d) mounted (elastically deformable) on a support, the arms having first and second end portions (4a-4d), and further tabs (see figure 4).

It would have been obvious to one with ordinary skill in the art to include wherein during the whole process the optical lens is carried by the same lens holder so that said at least one main face is freely accessible and without necessitating manual handling of the lens, further including the recitations of claims 2-6, 16, 19-20, 39-42, 52, 55-56 because Bracher et al teaches lens coating difficulties requiring holding techniques (col 1, lines 10-23).

Regarding dimensions claimed in claims 17-18, 34-35, 53-54, such would have been obvious to one with ordinary skill in the art as routine optimization dependant on coating to be applied, type of lens utilized, in absence of a criticality of result.

8. Claims 12-14, 29-31, 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al as applied to claims above, and further in view of Detting et al.

Nakazima et al, the admitted prior art, and Bracher et al all do not disclose second end portions of each arm made of or covered with electrically conductive material, further a metal, further aluminium.

Detting et al discloses use of aluminum (col 4, lines 35-37).

It would have been obvious to one with ordinary skill in the art to include aluminum for the purposes of strength and durability.

9. Claims 21, 22, 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al as applied to claims above, and further in view of Mostrocco.

Bracher et al discloses multiple arms, recess and inclined sidewalls.

Nakazima et al, the admitted prior art, and Bracher et al all do not disclose a pair of parallel rails, first and second arms movable by translation on the pair of rails, an intermediate portion.

Mostrocco discloses a pair of parallel rails (26,28), first and second arms movable by translation on the pair of rails (20, 36), an intermediate portion (32).

It would have been obvious to one with ordinary skill in the art to include a pair of parallel rails, first and second arms movable by translation on the pair of rails, an intermediate portion for the purpose of added adjustability and strength to the holder.

Regarding dimensions claimed in claims 34-35, such would have been obvious to one with ordinary skill in the art as routine optimization dependant on coating to be applied, type of lens utilized, in absence of a criticality of result.

10. Claims 7-8, 15, 24-25, 32, 43-44, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al as applied to claims above, and further in view of Moffatt.

Nakazima et al, the admitted prior art, and Bracher et al all do not disclose the second end portion of each arm comprising a material that is electrically insulating, having a specific dielectric constant as recited in claims 7-8, 24-25, 44.

Moffatt discloses an insulative layer on a holder that requires good dielectric properties (col 5, lines 50-66).

It would have been obvious to one with ordinary skill in the art to include a second end portion of each arm comprising a material that is electrically insulating, having a specific dielectric constant because Moffatt teaches substrate characteristics requiring flexibility for holding means.

Regarding specific dielectric constants claimed, such would have been obvious to one with ordinary skill in the art as routine optimization dependant on coating to be applied, type of lens utilized, in absence of a criticality of result.

11. Claims 9-10, 26-27, 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al as applied to claims above, and further in view of Jung.

Nakazima et al, the admitted prior art, and Bracher et al all do not disclose the material of the second end portions having specific heat characteristics as claimed.

Jung discloses specific heat characteristics as important for substrate coating (col 3, lines 34-63).



It would have been obvious to one with ordinary skill in the art to include disclose the material of the second end portions having specific heat characteristics as claimed because Jung teaches specific heat as one factor for coating effect.

Regarding specific heat lower limit claimed, such would have been obvious to one with ordinary skill in the art as routine optimization dependant on coating to be applied, type of lens utilized, in absence of a criticality of result.

12. Claims 57, 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al as applied to claims above, and further in view of Suzuki et al.

Nakazima et al, the admitted prior art, and Bracher et al all do not disclose a two corona head system as claimed in claims 57, 59-60.

Suzuki et al teaches a two headed corona system (figure 8).

It would have been obvious to one with ordinary skill in the art to include the recitations of claims 57, 59-60 because the admitted prior art teaches corona treatment as conventional and Suzuki et al teaches lens treatment with two heads so to prevent damage from using only one (col 13, lines 21-32).

Regarding Claim 61, the subject matter is an obvious variant of claim 57 as evidenced by Applicant's admission in the response filed 2/11/2008 and 6/26/2009, and thus would have been obvious over the above cited art.

13. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazima et al in view of the admitted prior art and further in view of Bracher et al

further in view of Suzuki et al as applied to claims above, and further in view of Yuasa et al.

Nakazima et al, the admitted prior art, Bracher et al and Suzuki et al all do not disclose the two corona heads as not in register to avoid electrical arc simultaneously treated.

Yuasa et al discloses avoiding electrical arc by electrode placements (col 3, lines 30-36).

It would have been obvious to one with ordinary skill in the art to include the two corona heads as not in register to avoid electrical arc simultaneously treated because Yuasa et al teaches avoiding electrical arc.

#### ***Response to Arguments***

14. Applicant's arguments filed 6/26/2009 have been fully considered but they are not persuasive. Applicant disagrees that it would have been obvious to introduce a corona discharge or atmospheric plasma treatment into the process of Nakazima based on "admitted prior art" and requests that the Examiner point to teachings in the prior art for each element of the claimed invention. The instant specification states on p. 2, lines 15-25, that it was "**common** to subject a lens face, uncoated or coated, to a corona discharge or atmospheric plasma treatment...in order to improve adhesion of the coating on the lens main face" (emphasis added). Thus, based on the admitted prior art on p. 2 of the instant specification, it would have been obvious to incorporate a corona discharge or atmospheric plasma treatment into the process of Nakazima in order to improve adhesion of the coating on the lens (See MPEP 2129).

Applicant further argues that even if the corona discharge or atmospheric plasma treatments were known per se, their incorporation in a continuous process, which does not necessitate any manual handling, cannot be apart of any alleged "admitted prior art." The admitted prior art from p. 2 as discussed above discloses that it was common to incorporate a corona discharge or atmospheric plasma treatment to improve adhesion, but the lens is just placed on a flat belt and the operator must manually turn the lens to coat both faces. Bracher discloses a lens holder wherein both faces of the lens are freely accessible for surface treatment (coating) without manual handling during a continuous process (Fig. 1, Abstract). Thus, taking the teachings collectively, it would have been obvious to the skilled person to modify the process of Nakazima by incorporating a corona discharge or atmospheric plasma treatment as suggested by the admitted prior art to improve adhesion and by incorporating a lens holder as suggested by Bracher in order to overcome the problem of manually turning the lens such that process time would be reduced.

Applicant argues that the lens holder of Bracher does not disclose or suggest the specific features of the lens holder as presently claimed, namely that the "second end portion" of branches 1a and 4a are not "facing each other." The lens holder, as presently claimed in claim 1, does not require that the "second end portions" of the arms are facing each other. The claim requires that the "second end portions" of each arm are adapted to accommodate an optical lens. The "second end portions" (4a) in Bracher are adapted to accommodate an optical lens.

Applicant argues that Bracher does not disclose or suggest that the lens is only maintained through one or two contact points between the lens periphery and each of the second end portions. The claim does not require that the lens is maintained through one to two contact points between the lens periphery and each of the second end portions. The claim requires that the lens is maintained through one to two contact points between the lens periphery and each of the **first and second arms**. Bracher discloses that each arm (1a-d) has a receiving groove 5 wherein a periphery edge of lens 11 is engaged. Thus, the lens is maintained within the first and second arms through one to two contact points between the lens periphery and each of the first and second arms.

Applicant argues that Bracher imperatively requires a specific structure of the lens periphery, namely the presence of a v-shaped ridge complementary to the v-shaped groove, which is contrary to the lens holder of the present invention which allows holding lenses whose periphery may be of any shape. First, Bracher discloses all of the claimed limitations of the lens holder recited in claim 1. The shape of the groove is irrelevant since the claim merely recites that the "lens can be maintained within the first and second arms...through one to two contact points between the lens periphery and each of the first and second arms." The groove of Bracher, no matter the shape, acts as a contact point to maintain the lens between the first and second arm", and thus meets the limitations of the claim. Second, Bracher also discloses that the holder may be modified by choosing grooves (different shapes) conforming to other substrates to be used, such as spectacle lenses and filter plates (Col. 4, lines 1-7).

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Burkhart whose telephone number is (571)272-6647. The examiner can normally be reached on M-Th 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth Burkhart/  
Examiner, Art Unit 1792

/Timothy H Meeks/  
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